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Application No.: 09/521,663

MAR 28 2008

Docket No.: 30980018US (1509-106)

REMARKS

The allowance of claim 59 and the indication of claim 14 containing allowable subject matter are noted. To this end, claim 14 has been combined with the claims upon which it depends.

The remaining claims have been amended to indicate the resource information required to print the at least one subsequent page is different from the resource information required to print the current page. This limitation is found, inter alia, on page 2, lines 11-14 and page 3, lines 18-23 of the application as filed. The remaining claims, except claim 54 and the claim dependent thereon, have been amended to indicate the resource information is included on the current page with the instruction data required to print the current page, a feature found, inter alia, on page 4, lines 19-22, and page 6, lines 19 and 20 of the application as filed.

Applicants object to the withdrawal of claims 17-24, 26, 28, 54 and 55 from consideration. The office action gives no reason why these claims are withdrawn from consideration. Based on this fact alone, the withdrawal is incorrect. If the withdrawal is based on a perceived difference in the withdrawn claims from the remaining claims that renders the withdrawn claims to be such that a restriction requirement is in order, the withdrawal is also wrong.

As set forth in MPEP Section 803 there are two criteria for a proper requirement for restriction between patently distinct inventions. The criteria are that the inventions must be independent or distinct as claimed and there must be a serious burden on the examiner if restriction is required. Section 803 also indicates examiners must provide reasons and/or examples to support conclusions for a proper restriction requirement. MPEP Section 811 and 37 CFR 1.142(a) indicate a restriction "requirement will be made before any action upon the merits; however, it may be made at any time before

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final action in the case at the discretion of the examiner." None of the foregoing criteria have been satisfied.

The examiner has not provided reasons and/or examples to support a conclusion for a proper restriction requirement. In addition, the prosecution of the application demonstrates that there has not been a serious burden on the examiner as a result of the failure to previously require restriction. There have been many office actions in connection with this application, and the issue of withdrawal of claims from consideration was not raised until after applicants filed an appeal brief. Further, there has been a final rejection in this case. Hence, the criteria cannot be satisfied. Accordingly, consideration of all claims is in order, as is removal of the withdrawal of consideration of claims 17-24, 26, 28, 54 and 55.

The office action includes statements by the examiner regard inherency and allegations of things that are well-known in the art. However, the examiner has failed to meet the requirements for a proper rejection based on inherency. In this regard, a proper rejection based on inherency must provide evidence or rationale to support the allegation and the allegedly inherent feature must be necessarily in the reference. MPEP Section 2112 and the decisions cited therein. In addition, the allegations of things that are well-known in the art do not meet the requirements of MPEP Section 2144.03 which indicates official notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art, are capable of instant and unquestionable demonstration as being well-known. Based on the foregoing, the rejection set forth in the office action fails to meet the established criteria for a proper rejection.

The anticipation rejection of claim 7 under 35 USC 102(b) is improper because a proper anticipation rejection requires all features of each claim to be included, either specifically or inherently, in a single reference, and cannot be based on obviousness. The rejection of claim 7 states "it would be obvious to a person of ordinary skill in the

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art" that the second information processing structure must be between the first information processing structure and the printer engine. Hence, the statutory basis for the rejection of claim 7 is wrong.

The submitted claims are patentable over the references applied against them. All the rejected independent claims, except claim 54, state the instruction data required to print the current page and the resource information indicative of printer processor resources required to print at least one subsequent page are sent to the printer on the current page.

Gerlach et al., US Patent 5,469,532, the primary reference relied on to reject the claims, discloses in Figures 3A-3C and column 10, lines 46-column 11, line 36, three different arrangements concerning the possible operation of resource assembler 208, Figure 2. The arrangement of Figure 3A is not relevant to the rejected independent claims because the font information for page 2 occurs in "document" 300 after the print instruction data for pages 1-3 has been transmitted and the bit-map information for page 3 is transmitted after print instruction data of the last page of the document, page n, has been transmitted. Figure 3B indicates the font information for page 2 and the bit-map for page 3 are transmitted before print instruction data of page 1 are transmitted. Column 11, lines 24-26 indicates the font information for page 2 and the bit-map for page 3 are at the beginning of the document, which Figure 3B indicates occurs before the print instruction data for page 1 are transmitted. Figure 3C indicates the font information for page 2 is transmitted between the print instruction data for pages 1 and 2 and that the bit-map information for page 3 is transmitted between the print instruction data for pages 2 and 3. Based on the foregoing and because resource assembler 208 converts the page description language (PDL) output of application program 204 into a set of draw primitives, generically referred to as a Render Primitives List (RPL) (column 10, lines 2-5, 23-31), Gerlach et al. does not send, on the current page, the instruction data required to print the current page to the printer processor together with the resource information indicative of printer processor resources required by the printer to

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print at least one subsequent page that requires resource information different from the resource information required to print the current page. Consequently, independent claims 1, 17, 21 and 35 distinguish over Gerlach et al.

Independent claims 52 and 54 distinguish over Gerlach et al. by requiring a computer to provide a printer processor with resource information as comments in page description language located in page headers for enabling the printer processor to learn, in advance of processing instruction data for a document printing stage, the printer resources required to process instruction data for that document printing stage. Gerlach et al. fails to disclose the use of comments or page description language being located in page headers.

One of ordinary skill in the art would not have modified Gerlach et al. as a result of the secondary references to cure the foregoing deficiencies in the primary reference.

Snipp, US Patent 5,699,495, relied on in combination with Gerlach et al. to reject claims 5, 8, 25 and 27, is not relevant to the foregoing deficiencies, but is concerned with connections between a computer and a printer.

One of ordinary skill in the art would not have modified Gerlach et al. as a result of Motoyama, US Patent 5,319,748, to arrive at the features of claims 10 or 29. Motoyama is relied on as a secondary reference to reject claims 10 and 29. The examiner relies on the discussion of the prior art in column 2 lines 37-39 of Motoyama which indicates that in the prior art (to Motoyama) PostScript document structuring convention comments were used to distinguish various resources and page breaks. However, claims 10 and 29 require the annotation to be in the form of comments in page description language and/or job control language. Claims 10 and 29 respectively depend on claims 3 and 23. (Curiously, claim 23 has been withdrawn from prosecution; consequently, there is no basis to consider the rejection of claim 29.) In the rejection of claim 3, the examiner apparently relied on the render primitives list (RPL) data to

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comprise the resource information that is provided as an annotation to the PDL and/or JCL. However, the position of the examiner concerning claim 10 is contrary to the position of the examiner with regard to claim 3. In particular, claim 10 requires the annotated comments to be in the page description language (PDL) and/or job control language (JCL), but the rejection of claim 3 appears to state the annotation is in RPL data. Further, one of ordinary skill in the art would not have looked to Motoyama to modify Gerlach et al. to include comments, because of the negative discussion Motoyama has of the PostScript document structuring convention.

The rejection of dependent claims 11-13, 15, 16, 30-34 and independent claim 52, upon which claim 53 depends, is a combination of four different references, namely Gerlach et al., the US Motoyama reference, Siegel, US Patent 5,678,133, and Motoyama, EP 0 538 059. Siegel is relied on to disclose, at column 6, lines 55-57, embedding a signal indicating that if a gloss adjustment for a fuser is desirable as a property of a given document page, such a signal can be embedded along with other page properties in a PDL editor, while the abstract of Motoyama (EP) is relied on to disclose that resource information can be posted at the beginning of each distinct document segment. The combination of references is a classic case of an examiner casting about to find bits and pieces of a claim and then putting them together without any basis. The alleged reason to combine the references is that the resource information can get to the printer prior to transmitting data to be printed. However, Gerlach et al. supplies the resource information to the printer in RPL prior to transmission of data to the printer. The office action does not explain why one of ordinary skill in the art would have substituted the approaches taken by the Siegel and Motoyama (EP) for the RPL approach Gerlach employs. Such hindsight combination of references is clearly improper.

In view of the foregoing amendments and remarks, allowance is in order.

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To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 08-2025 and please credit any excess fees to such deposit account.

Respectfully submitted,

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